UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,178	04/14/2004	Chitra Jain	67519.001042	6347

21967 7590 01/26/2009

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER	
JANVIER, JEAN D	

ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
01/26/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/824,178	JAIN ET AL.	
	Examiner	Art Unit	
	JEAN JANVIER	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

Specification

Claim Status

Claims 1-33 are currently pending in the Instant Application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 23 (including their dependent claims) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

In independent claims 1 and 23, each limitation should include a particular machine to **be** statutory under 35 USC 101. For instance, in claim 1, the "causing" and "providing" steps do not include a particular machine. Claim 23 suffers from similar deficiencies and it is rejected under a

similar rationale. (Also see, United State Court of Appeals for the Federal Circuit, 2007-1130, IN RE BERNARD L. BILSKI and RAND A. WARSAW).

Claims 12 and 28 (including their dependent claims) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Specifically, in independent claim 12, the preamble of the claim recites a device, indicating structure, means plus function or Hardware per se, whereas the body of the claim recites data or software per se (or never refers back to the device or structure recited in the preamble), which is not statutory. Here, in claim 12, "Purchase information module" and "Purchase information management module" and "customer service module" appear to be logic, program or software per se, not means or Hardware. In other words, the claim changes statutory class since the preamble talks about a system, while the body recites software per se, which is not statutory under 35 USC 101. Independent claim 12 changes from a statutory class (subject matter), in the form of a system as recited in the preamble, to a non-statutory subject matter or class, in the form of software per se as recited in the body of the claim.

Claim 28 suffers from similar deficiencies and it is rejected under a similar rationale.

Claim Rejections – 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 28 (including their dependent claims) are rejected under 35 U.S.C. 112, second paragraph as being confusing.

Specifically, in independent claim 12, the preamble of the claim recites a device, indicating structure, means plus function or Hardware per se, whereas the body of the claim recites data or software per se (or never refers back to the device or structure recited in the preamble), which is not statutory. Here, in claim 12, "Purchase information module" and "Purchase information management module" and "customer service module" appear to be logic, program or software per se, not means or Hardware. In other words, the claim changes statutory class since the preamble talks about a system, while the body recites software per se, which is not statutory. Independent claim 12 changes from a statutory class (subject matter), in the form of a system as recited in the preamble, to a non-statutory subject matter or class, in the form of software per se as recited in the body of the claim. That renders the claim confusing.

Claim 28 suffers from similar deficiencies and it is rejected under a similar rationale.

Claims 1-11, 12-22, 23-27, 28-32 and 33 are rejected, under 35 USC 112, second paragraph as being indefinite for reciting "RFID". Although the acronym "RFID" may be well understood in the art, however, it must be defined in the parent or independent claim at least once.

Claims 5, 6, 16, 17, 23, 25, 26, 28, 30 and 31 (including their dependent claims) are rejected, under 35 USC 112, second paragraph as being indefinite for reciting the auxiliary verb "may", which creates a certain uncertainty therein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6-11, 12, 14-22, 23, 25-27, 28, 30-32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Giordano, WO 97/24689.

As per claims 1, 3, 6-11, 12, 14-22, 23, 25-27, 28, 30-32 and 33, Giordano discloses a method of and a system for providing a fuel dispenser (14) with radio frequency customer identification capabilities via customers' transponders (wireless devices or RF devices) mounted on vehicles or handheld (key chain, fob, etc.) transponders having RFID devices coupled thereon. The system and method determine whether a transponder (23, 25) containing customer identification data is within (proximity) range of a dispenser (14) that requires activation by the customer to initiate a transaction, such as a fuel transaction, and has an associated reader (20) for emitting radio frequency signals and receiving customer identification data from the transponder (23, 25) responsive to the emitted radio frequency signals (detecting the presence of a customer within a business establishment). When the transponder (23, 25) is within range of the dispenser, an in-range indication is provided to the customer carrying the transponder. Upon activation of the dispenser (14) following a determination that the transponder (23, 25) is within range, the customer identification data (CID) received by the reader (20) is associated with a current transaction at the activated dispenser. The transaction at the activated dispenser (14) is then permitted and charged to the customer's account according to the customer identification data as

read from the transponder. Once the customer is properly identified, the transaction is allowed according to a generated or pre-determined plan **or the customer's account** and the value of the transaction or balance due is charged to the customer's account (reading on receiving purchase information from one or more purchases made by a customer from an affiliate or particular merchant using a transponder having RFID tag coupled thereto (i.e. financial card with an RFID tag) that stores a financial account and the customer's identification data (CID), the purchase information includes one or more items, such as gasoline, purchased during one or more transactions……).

Further, Giordano teaches providing loyalty benefits (engagement plan or service) to the customer, based on the customer's profile (tracking or monitoring data or purchase history of the customer **stored in a storage separate from the financial card or customer's transponder**), during one or more transactions conducted via the transponder or remote communication unit (i.e. financial card), in which the customer's (financial) account is charged accordingly.

Following a validation process at the POS, upon reading the customer identification data (CID) from the memory of the transponder (i.e. RFID device), a sale is permitted wherein the customer can dispense fuel and/or order goods, such as food, services, car wash at the pump, all of which is charged to the customer's (financial) account identified by the transponder (based on the read CID). **The system may offer, by displaying a promotional message on a display (CAT) terminal, to the customer a free car wash (personalized service) <u>if the customer has purchased fuel a certain number of times</u> (as read from the customer's collected purchase history conducted via the transponder or in association with the CID and/or financial account)**. The Customer's information (i.e. purchase history) is stored in the system database.

The system or host may also store a copy of the customer's information into the customer's transponder memory, which is periodically updated by the system. In other words, the system or network keeps track of the customer's past purchases and buying preferences and provides rewards for frequent purchases (storing the customer's purchase history in a separate database, conducted via a transponder or in association with the CID and/or financial account, and providing customized or tailored service or rewards to the customer based on the stored purchase history). When a transponder is read at a business facility, the CAT or terminal, related to the fuel dispenser, can display a message indicating rewards (engagement plan), such as a free car wash, that the customer is entitled to. The network or system also stores the customer's profile, such as name, address, payment account information, preferred method of payment, preferred language and so forth, and provides customized service for the customer based on the stored profile (determining or generating an engagement plan for the customer in accordance with the customer's profile).

See abstract; figs 1-31; page 5: 9 to page 6: 17; page 13: 15 to page 24:16; page 30: 22-32; page 35: 32 to page 36: 20; page 55: 5-25.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 10-11, 12-16, 21-22, 23-25, 28-30 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hind US 20020174025A1.

As per claims 1-5, 10-11, 12-16, 21-22, 23-25, 28-30 and 33, Hind discloses, in one embodiment, a wireless communication device in the form of a shopping cart attachment device attached to a shopping cart operated by the customer. **The customer is provided with a**

customer card such as a RFID (Radio Frequency Identification) tagged card, which is pre-stored with the customer's preference information (including purchase data or history). The shopping cart attachment device is configured to scan the preference information from the customer card carried by the customer. Then the scanned preference information is communicated to the data processor using short-range wireless communication techniques. Based on this preference information, the data processor provides targeted advertising and/or personalized customer service to the customer using a display device of the shopping cart attachment device [0012]. In accordance with another embodiment, each customer's preferences (including purchase data or purchase history) are pre-stored in a central location and are associated with a unique customer ID. **The customer ID is stored on the customer card** carried by the customer. The shopping cart attachment device reads the customer ID from the customer card (including a credit card having a financial account). Based on this customer ID, the data processor retrieves pre-stored preference information associated with this customer ID. Based on the retrieved preference information, the data processor provides targeted advertising and/or personalized customer service to the customer on a display device of the shopping cart attachment device (storing the purchase history or preference in a central computer, identifying the card or financial account based on the customer's ID read from the card memory and displaying a tailored service to the customer based on the preference or purchase history-fig, 4; [0013], [0024]). All of those customer services are provided or displayed to the customer based on the customer's preference information such as the customer's preferred products, brands, sizes, price range, color, stores, language, currency, etc., so that most appropriate and personalized customer services can be provided to the customer. Any information necessary to provide such

customer services can be stored in the customer service database 17 of fig, 4 or other location accessible by the data processor 14 [0026].

Further, with respect to fig. 4, the customer card reader 55 is a conventional card reader for **reading a customer card 62 such as a membership card, a credit card, a debit card, a customer ID card such as Harris Teeter's VIC, etc**. The customer card **62 includes a storage unit 80 for storing** the customer's personal information (including ID). **The storage unit 80 can be in the form of an optical medium, a magnetic stripe, a chip, a RFID (Radio Frequency Identification) tag, a hologram, etc.** Depending on the type of the storage unit 80, the type of the customer card reader 55 will vary. For example, if the storage unit 80 of the customer card 62 is a RFID tag, the customer card reader 55 will be a RFID tag reader for scanning radio signals from the RFID tag wirelessly. If the storage unit 80 of the customer card 62 is a semiconductor chip, then the customer card reader 55 is a smart card reader for reading the chip when the customer card 62 is inserted into the card reader 55. All these storage units and card readers are well known in the art [0032] (the customer's card or financial card 62, such as a credit card, having a memory 80 in the form of an RFID tag or RFID device for storing a customer ID and default financial information including a financial card account; the system is configured to retrieve the customer's preference information or purchase data or history from a central database based on the identity (ID) of the customer's read from the card memory 80 and to display tailored services to the customer based on the retrieved information……[0035]-[**0036**]).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 6, 422, 464 to Terranova teaches a system or a fuel dispensing system including a fuel dispenser associated with a control system and a receiver adapted to receive signals, including identification indicia from a remote communications unit (transponder, handheld device, fob, etc. having an RFID tag coupled thereto) associated with a customer when a cash, credit or pre-paid transaction is indicated within an establishment or gas station. A cash transaction indicator is adapted to signal the control system that a cash transaction is taking place, and may be selectable by the customer or an operator of the system at the beginning of the transaction. The system also includes a transmitter adapted to transmit the customer-related information to the remote communication unit (transponder) associated with the customer where it is locally stored or has memory for storing the customer-related information in association with the identification indicia. The system is further configured to store credit for change due to the customer based on a cash transaction and provide and store loyalty points on or in association with the customer's transponder (determining an engagement plan related to the customer-See abstract). Terranova further discloses a system configured to provide various types of loyalty benefits (engagement plan) based on past and/or current transactions. Loyalty benefits will be provided to a customer in order to encourage subsequent return to a particular fueling environment or one of an associated group of environments. The benefit may also encourage the purchase of additional products during the current or a subsequent transaction. The benefits may include cash rebates or discounts providing a type of electronic couponing to enhance merchandising and marketing efforts. A loyalty point may be earned by a customer for each transaction, transaction amount, or type or quantity of a particular product or service. For example, a loyalty point may be earned for each gallon of gas purchased or for a fill-up requiring eight or more gallons of gas. The store

operators have tremendous flexibility in determining the various criteria for earning loyalty points. Additionally, the loyalty benefits or points (stored in the customer's transponder memory) are preferably redeemed by a customer in part or in whole on subsequent visits to the same or an associated fueling environment when the customer's presence is detected within an establishment via his transponder storing at least the customer's identification or indicia. Redeeming points at a subsequent transaction provides an incentive for a customer to return to environments participating in the benefit program. Although redeeming points on a subsequent purchase is preferred, benefits may be made immediately available based solely on the current transaction. Furthermore, the benefits may be based upon current and prior transactions and allow for both current and subsequent benefit. The transponder (fob or card) can be charged or used to pre-pay for gasoline (col. 14: 59: 63 to col. 15: 60; FIG. 10C). See col. 15: 63 to col. 19: 8; figs. 26A and 9; col. 11: 5-20.

US 20040093265A1 to Ramchandani discloses a method for outputting information about a person includes identifying the person utilizing a wireless system upon entry into a physical location, and also includes locating the person within the physical structure. An engagement plan is retrieved based on the identification of the person and output. The engagement plan has information useful for interacting with the person. The engagement plan is created based at least in part on personal information of the person, the preferences of the person, and the past transactions of the person. A system for outputting information about a person, such as a customer, includes an object carried by the person, which is capable of being identified by a wireless system. A wireless interface communicates with the object. A computing device

correlates the identification of the object with the person. An output device outputs information relating to the person (See abstract).

01/19/09

/J. J./

/Jean Janvier/

Primary Examiner, Art Unit 3688